

REMARKS**Summary of the Office Action**

Claims 23 and 24 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Claims 1-24 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly based on a disclosure, which is not enabling.

Claims 1 and 21-22 are rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Publication No. 2001/0030827 A1 to Morohashi (hereinafter "Morohashi") further considered with U.S. Patent No. 5,987,417 to Heo et al. (hereinafter "Heo").

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,362,928 to Hamai et al. (hereinafter "Hamai").

Claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 99/34601 to Otomo et al. (hereinafter "Otomo") further considered with U.S. Patent No. 5,619,483 to Yokota et al. (hereinafter "Yokota").

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 1-3 above, and further in view of Yokota.

Claims 8-16, 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Heo.

Claims 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of U.S. Patent No. 6,226,441 to Hartung et al. (hereinafter "Hartung").

Claims 23-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1-3 above, and further in view of allegedly “well known word processing nomenclature and the Dewey-Decimal system.”¹

Summary of the Response to the Office Action

Applicants have amended claims 1, 2, 23, and 24. Claims 1-24 are presently under consideration.

Rejections under 35 U.S.C. § 112, First Paragraph

The Office Action rejects claims 1-24 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicants respectfully traverse the rejection for the following reasons.

The Office Action takes the position that the phrase “after changing a part of the group information,” is not described in the specification. Applicants have removed the above mentioned phraseology.

As pointed out at page 14 of the Amendment filed on September 13, 2004, embodiments of the instant application include a novel feature of recording tracks of recorded information onto an information recording medium, by automatically grouping the tracks being recorded based on group control information generated by an information attaching and generating device, as recited as in the claims of the instant application.

The Background of the Invention portion of the instant application describes how as the recording capacity of recent recording medium formats increases, it becomes more and more

¹ Because the Office Action does not specifically identify all of the applied references by document numbers, to clarify the record, Applicants request that the next Office Communication inform them if any of Applicants' above-stated understandings regarding the specific document numbers of the applied references are incorrect.

complicated for a user to manually assign each of the recorded pieces on the medium to a particular group. See, for example, page 3, lines 2-6 of the specification.

As discussed throughout the specification of the instant application, the recording apparatus disclosed in the instant application solves this problem by greatly simplifying the recording process because the user does not need to manually perform grouping operations himself when recording tracks onto the medium. Instead, the grouping processing is performed by the system controller 51, instead of by the user. In other words, the grouping processing is automatically performed when a change in track recording is detected. See, for example, page 34, lines 17-26 and the final sentence of the Abstract. See also page 19, line 12 through page 20, line 9, page 20, line 23 through page 21, line 4, page 22, lines 5-11, page 23, lines 12-23, page 25, lines 9-22, for example. Numerous other portions of the specification also describe various aspects of this feature.

This feature is covered by the recitations of independent claim 1. For example, claim 1 recites an information recording apparatus that includes “an information attaching and generating device” and “a detection device.” The “detection device” is recited as “giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected.” Thus, the above-discussed “automatic grouping instruction” feature is met because the components of the claimed information recording apparatus themselves generates and transfer the grouping instruction upon a particular change in track recording being detected. In other words, the user does not need to manually perform grouping operations himself when recording tracks onto the medium, as discussed above and throughout the specification.

Applicants respectfully assert that the above-mentioned features are fully enabled in the specification and that one of ordinary skill in the art would have understood that these portions of the specification, when read in context with the entire specification, support claims 1-24.

Furthermore, it is respectfully submitted that Applicants' specification enables one of ordinary skill in the art to make and use the claimed invention. Accordingly, the rejections under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Rejections under 35 U.S.C. §§ 102 and 103(a)

Claims 1 and 21-22 are rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Morohashi further considered with Heo. Applicants respectfully traverse the rejections for the following reasons.

Applicants respectfully submit that the Office Action has not established that Morohashi anticipates each and every feature of Applicant's claimed invention and thus all rejections under 35 U.S.C. § 102(a) should be withdrawn. Namely, Applicant contends that independent claim 1 recites the feature of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information." At least these features are not disclosed or taught by Morohashi.

Applicants respectfully submit that Morohashi does not meet the limitations of newly amended claim 1, as asserted by the Office Action because Morohashi merely discloses an apparatus which includes information for managing a plurality of music data as a music collection, and performs reproduction control by each music collection. Morohashi does not

teach, or even suggest, a recording apparatus which performs grouping processing during recording of data, in the manner recited in newly amended claim 1.

Applicants also respectfully submit that these features are absent from, and are neither disclosed nor taught, alone or in combination, by either Morohashi or Heo in independent claim

1. To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Heo is directed to a DVD audio disk reproducing device and method thereof. Heo does not involve an information recording apparatus for recording information onto a disc in the manner discussed in the claims of the instant application. Accordingly, Applicants respectfully submit that Heo also does not meet the limitations of newly amended independent claim 1 at least because it does not teach or suggest an information recording apparatus in which users do not need to perform grouping operations themselves when recording tracks onto the medium. Heo does not disclose an arrangement in which a user is recording tracks on the disc himself. As a result, Heo clearly does not disclose, or even suggest, an arrangement in which such grouping of tracks is automatically performed while a user is recording tracks onto a medium in the manner recited in the claims of the instant application. Applicants respectfully submit that Heo merely discloses a method of reproducing a DVD audio disc. Heo does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102 and 103(a) should be withdrawn because the applied art of record, whether taken singly or in combination, does not teach or suggest each feature of newly amended independent claim 1. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 2-24 are allowable at least because of the dependence from independent claim 1, and the reasons set forth above. Moreover, any additional references applied against the dependent claims do not cure the above-described deficiencies of the references applied against independent claim 1.

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hamai. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that Hamai anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation

relating to track recording is detected during recording of information.” At least these features are not disclosed or taught by Hamai.

Hamai discloses an apparatus for recording and reproducing digital data according to the present invention, and more particularly to an apparatus for recording blocked digital data on a magnetic tape and a method for the same. See Hamai at col. 1, lines 10-14. However, Hamai fails to teach or suggest at least the above features of claim 1.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because Hamai does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Rejections under 35 U.S.C. § 103(a)

Claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Otomo further considered with Yokota. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that Otomo or Yokota teach or suggest each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the features of “an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device

for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information.” At least these features are not taught or suggested by either Otomo or Yokota.

Applicants respectfully submit that neither Otomo nor Yokota teach the limitations recited in at least independent claim 1. For example, the portions of Otomo applied by the Examiner refer to a user’s ability to control playback of music on a DVD audio disc 10 produced with the hierarchical structure shown in Fig. 9 of Otomo. In other words, Otomo merely teaches the use of a recording medium that includes a pre-stored hierarchical structure of audio which allows a user to control the playback of the audio by, for example, jumping directly to a particular musical composition on the disc, or to a specific portion of a particular musical composition on the disc. Such an arrangement is well known in the related art.

More particularly, Otomo merely discloses a management structure for utilizing AUDIO information in both of contents recorded in DVD-AUDIO format and contents recorded in DVD-VIDEO format in the case where these contents are recorded in one recording medium. As a result, Applicants respectfully submit that Otomo merely discloses the well-known structure of the DVD-AUDIO format, in which contents are managed hierarchically, having a first level hierarchy (group), a second level hierarchy (track), and a third level hierarchy (index) (see, for example, FIG. 9). Accordingly, Otomo disclosure merely manages contents by using a group and track. In Otomo, a user has to choose a group to record each track. Therefore, Otomo does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

The arrangements and methodologies described in the instant application, on the other hand, involve a novel way to record tracks of recorded information onto an information

recording medium, by automatically grouping the tracks being recorded based on group control information generated by an information attaching and generating device, as recited in the claims of the instant application. As discussed in the specification of the instant application, the recording apparatus disclosed in the instant application greatly simplifies the recording process because users do not need to perform grouping operations themselves when recording tracks onto the medium. This is because the grouping is automatically performed when a change in track recording is detected, as recited in the claims of the instant application.

Otomo merely discloses that a user can jump to particular musical portions, that have previously been recorded on a disc, based on the recorded group information. It does not disclose an arrangement in which the user is recording tracks on the disc himself. As a result, like Morohashi discussed above, Otomo clearly does not disclose, or even suggest, an arrangement in which such grouping of tracks is automatically performed while the user is recording tracks onto a medium.

As stated in the Office Action, Yokota is applied only for the teachings of the dependent claims. Nevertheless, Applicants respectfully submit that Yokota also does not cure the above-noted deficiencies of Otomo with regard to independent claim 1. For example, Applicants respectfully submit that Yokota merely discloses a recording apparatus which automatically generates a track reference number and records the track. Therefore, Yokota does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Hamai above, and further in view of Yokota. Applicants respectfully traverse the rejection for the following reasons.

Yokota shows an invention that relates to a recording method of recording medium and more particularly, relates to a recording method for recording digital signals supplied with an additional information to a recording medium. See Abstract of Yokota.

Applicants respectfully submit that the Office Action has not established that Yokota teaches or suggests each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the features of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information." At least these features are not taught or suggested by Yokota.

Yokota does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1. Yokota does not make-up for the deficiencies of Hamai. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because Yokota does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 4-7 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 8-16, 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Hamai above, and further in view of Heo. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that Heo teaches each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information." At least these features are not disclosed or taught by Heo.

Heo is directed to a DVD audio disk reproducing device and method thereof. Heo does not involve an information recording apparatus for recording information onto a disc in the manner discussed in the claims of the instant application. Accordingly, Applicants respectfully submit that Heo also does not meet the limitations of newly amended independent claim 1 at least because it does not teach or suggest an information recording apparatus in which users do not need to perform grouping operations themselves when recording tracks onto the medium. Heo does not disclose an arrangement in which a user is recording tracks on the disc himself. As a result, Heo clearly does not disclose, or even suggest, an arrangement in which such grouping of tracks is automatically performed while a user is recording tracks onto a medium in the manner recited in the claims of the instant application. Applicants respectfully submit that Heo merely discloses a method of reproducing a DVD audio disc. Heo does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1. Heo does not make-up for the deficiencies of Hamai.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art of record, whether taken singly or in combination, does not teach or suggest each feature of newly amended independent claim 1. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 8-16 and 21-22 are allowable at least because of the dependence from newly amended independent claim 1, and the reasons set forth above.

Claims 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Hamai above, and further in view of Hartung. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that Hartung teaches each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the features of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information." At least these features are not disclosed or taught by Hartung.

Hartung provides an invention pertaining to the recording and/or reproduction of information on magnetic tape media. See col. 1, lines 50-51 of Hartung. Hartung does not make-up for the deficiencies of Hamai.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art of record, whether taken singly or in combination, does not teach or suggest each feature of newly amended independent claim 1. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 17-20 are allowable at least because of the dependence from newly amended independent claim 1, and the reasons set forth above.

Claims 23-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Hamai above, and further in view of allegedly "well known word processing nomenclature and the Dewey-Decimal system."² Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that Dewey-Decimal system teaches each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the features of "an inputting operation device for performing an inputting operation in accordance with a user's instruction; and a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information." At least these features are not disclosed or taught by Dewey-Decimal system.

² Because the Office Action does not specifically identify all of the applied references by document numbers, to clarify the record, Applicants request that the next Office Communication inform them if any of Applicants' above-stated understandings regarding the specific document numbers of the applied references are incorrect.

The Dewey-Decimal system does not make-up for the deficiencies of Hamai.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art of record, whether taken singly or in combination, does not teach or suggest each feature of newly amended independent claim 1. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that dependent claims 23-24 are allowable at least because of the dependence from newly amended independent claim 1, and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted

MORGAN, LEWIS & BOCKIUS LLP

By: _____



David B. Hardy
Reg. No. 47,362

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Customer Number 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004-2541

Phone: (202) 739-3000

Fax : (202) 739-3001